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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,973	02/25/2004	Toshiaki Igarashi	03500.100142.	8991
5514 7590 10/31/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
NGUYEN, CINDY				
ART UNIT		PAPER NUMBER		
2161				
MAIL DATE		DELIVERY MODE		
10/31/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/784,973

**Applicant(s)**

IGARASHI, TOSHIAKI

**Examiner**

CINDY NGUYEN

**Art Unit**

2161

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 07/18/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is response to amendment filed 08/07/08

#### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 07/18/08 is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-9, 11-13, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over James Michael Metz, US Patent Publication No. 2004/0019671 and hereinafter referred to as Metz in view of Babu et al. (US 6122639, hereafter Babu).

As to claims 1,2,6,9, 12 and 13, Metz teaches a network device (Fig. 4A; [0004]) managing apparatus comprising:

storage unit adapted to store, a device list (the main list 302) indicating network devices found by a search, the device list being associated with identification information that identifies a data processing apparatus that requested the search; (i.e., to search the main list 302 for information matching specific criteria, for example, when a printing device 102 is discovered on the network 100, information pertaining to the device, such as its IP address, hostname, printer model, capabilities, etc., is stored in cache (memory 208) of the network... see paragraph 0025, Metz);

receiving unit adapted to receive a search request for a new search of network devices (Fig. 4A; [0004, 0024, 0025] and identification information of a data processing apparatus initiating the search request from the data processing apparatus initiating the search request (i.e., printing device information such as: a model type, hardware address, port, IP address, iP host, status of the printer device, 0021, 0022);

searching unit adapted to perform a new search for network devices in response to the search request received by the receiving unit (i.e., filter queries the main device list for information that satisfies one or more criteria for each secondary list. (0024));

obtaining unit adapted to obtain from the storage unit the stored device list (if any) associated with the identification information received by the receiving unit, the obtained device list indicating a search result obtained in a search prior to the new search performed by the search unit; (i.e., filter queries the main device list for information that satisfies one or more criteria for each secondary list. (0024, 0025)), the past device list indicating a search result at the time when searched before the

search by said searching unit (i.e., network management tool 104 can send a query to all printing devices on network and listen for responses and/or can monitor the network for signals indicating that printing devices are present on the network... discover new printer and updating the main device list (0022).

However Metz didn't disclose: a comparing unit adapted to compare the search result provided by the searching unit with the device list obtained by the obtaining unit; forming unit adapted to specify any the network devices located in the new search by said searching unit but not present in the device list obtained by the obtaining unit, and to form a new device list in which such specified network device are emphasized among network devices found by the new search; Transmitting unit adapted to transmit the new device list formed by the forming unit to the data processing apparatus.

.On the other hand, Babu discloses: a comparing unit adapted to compare the search result provided by the searching unit with the device list obtained by the obtaining unit (see col. 15, lines 28-30, lines 41-45, Babu);

a forming unit adapted to specify any the network devices located in the new search by said searching unit but not present in the device list obtained by the obtaining unit, and to form a new device list in which such specified network device are emphasized among network devices found by the new search (see col. 15, lines 7-10,; col. 14, lines 19-26, Babu);

Transmitting unit adapted to transmit the new device list formed by the forming unit to the data processing apparatus (see col. 14, lines 19-26; col. 15, lines 7-10, Babu).

Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include comparing unit and an obtaining unit and transmitting unit in the system of Metz as taught by Babu. The motivation being to provide the change detection mechanism ensures that changes detected in a device are stored and allows a clear distinction between previously collected information sets and a newly collected information sets on a network device (see col. 4, lines 43-50, Babu).

As to claims 4, 7 and 11, Metz/Babu teaches wherein the device list formed by the data forming means includes an emphasis mark to emphasize ([0040]).

As to claims 5 and 8, Metz/Babu teaches wherein the device list formed by the data forming means includes instruction data for allowing a device icon of the data processing apparatus to be displayed in an updated state (see col. 14, lines 18-26, Babu).

As to claims 15 and 17, Metz teaches wherein the identification information is a network address of the data processing apparatus (i.e., printing device information such as IP address, IP host, hardware address, 0021).

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over James Michael Metz, US Patent Publication No. 2004/0019671 and hereinafter referred to as Metz in view of Babu et al. (US 6122639, hereafter Babu) and further in view of Boldt et al. (US 6349304) (hereafter Boldt).

As to claims 3 and 10, Metz didn't teaches wherein the device list formed by the forming unit indicates at least one of information regarding whether printing is possible or not and an error state. On the other hand, Boldt discloses: wherein the device list formed by said forming unit indicates at least one of information regarding whether printing is possible or not and an error state (i.e., indicated whether the printer 8a, b,c,d should continue printing after a printing error, col. 4, lines 42-48). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include said list indicates at least one of information regarding whether printing is possible or not and an error state in the system of Metz as taught by Boldt. The motivation being to determined set of features may be transmitted to different target devices when the target devices have different capabilities with respect to the determined set of features, the target devices are configured with the values transmitted over the network, col. 1, lines 57-62, Boldt.

#### Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cindy Nguyen

/C. N./



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Art Unit: 2161

Examiner, Art Unit 2161

/Apu M Mofiz/

Supervisory Patent Examiner, Art Unit 2161